

### **Remarks**

The Applicant has amended the Specification to place it into final condition for allowance. Entry into the official file is respectfully requested.

Claims 1, 2, 4 and 8-14 stand rejected under 35 U.S.C. §103 over the hypothetical combination of Simopoulos with Boo and JP '466. The Applicant respectfully submits that one skilled in the art would not make the hypothetical combination, but in any event, the hypothetical combination would still fail to teach or suggest the subject matter of Claims 1, 2, 4 and 8-14. Detailed reasons are set forth below.

Boo discloses a new agent for protecting cells against active chemical oxygen species. That agent is obtained by mixing complete leaves or purified extract of *Camellia sinensis* L., *Alpinia officinarum* Hance roots and *Scutalleria baicalensis* Georgi roots, which contains at least one biochemically active flavonoid (EGCG, galangine or baicaleine). Boo also discloses that the purified extract of *Camellia sinensis* contains EGCG and the extract of *Alpinia officinarum* Hance is the galangine extract. One skilled in the art can deduce that from the name "*Scutalleria baicalensis* Georgi", the baicaleine comes from *Scutalleria baicalensis* Georgi. Thus, Boo teaches that a mixture comprising EGCG, galangine and baicaleine is an agent for protecting cells against active chemical oxygen species.

However, the Applicant respectfully submits that Boo does not teach or suggest anything about the use of the new agent as a cosmetic. Moreover, it does not teach or suggest that the beneficial effect is obtained by the extract of *Alpinia officinarum* Hance. Instead, it teaches that the benefit is obtained by a mixture of several components.

Furthermore, one skilled in the art is led, in an effort to obtain an extract of *Alpinia officinarum* Hance containing galangine, to make a water insoluble extract. In other words, Boo leads to an organic solvent soluble extract inasmuch as galangine is insoluble in water but soluble in organic solvents. The Applicant invites the Examiner's attention to the enclosed Merck Index, Eleventh Edition, 1989, page 679, which demonstrates this fact.

Hence, Boo would lead one skilled in the art to use a mixture of the three extracts and not to specifically choose the extract of *Alpinia officinarum* Hance. Also, assuming Boo would lead one skilled in the art to use the extract of *Alpinia officinarum* Hance, such use would be the water insoluble extract or the organic solvent soluble extract, not the claimed water-soluble extract.

Consequently, Boo would not only not lead one skilled in the art to the rejected claims, but would lead them away from that subject matter.

Simopoulos discloses compounds present in Purslane. More precisely, it concerns the rate of unsaturated fatty acids in Purslane samples. Simopoulos teaches that samples of Purslane contain omega-3 fatty acids, such as alpha-linolenic acid. However, alpha-linolenic acid is insoluble in water as shown by the enclosed Merck Index, Eleventh Edition, 1989, page 867. Thus, it cannot be part of a water soluble extract. Instead, it can be part of an organic solvent soluble extract, which is not what the Applicant claims.

Consequently, one skilled in the art, to obtain an extract comprising alpha-linolenic acid, would use a water insoluble extract or an organic solvent soluble extract. Thus, Simopoulos leads those skilled in the art away from the claimed subject matter.

The Applicant respectfully submits that one skilled in the art would not hypothetically combine Simopoulos with Boo. As noted above, Simopoulos relates to “a nutritious food” while Boo relates to a “new agent for protecting cells.” The Applicant respects that there would be no incentive for one skilled in the art to make the hypothetical combination. However, even if the hypothetical combination were to be made, there is no disclosure of the claimed “cosmetic composition.” Therefore, there is no incentive to make the combination and the combination would still fail to teach or suggest the subject matter of Claims 1, 2, 4 and 8-14.

There is still, however, a further problem with a hypothetical combination of Simopoulos with Boo. In that regard, the Applicant has already established that *Alpinia officinarum* Hance contains galangine which is insoluble in water and soluble in an organic solvent. The Merck Index factually establishes this. Similarly, the Applicant has already established that Purslane contains omega-3 fatty acids including alpha-linolenic acid. However, alpha-linolenic acid is insoluble in water, also factually established by the Merck Index. Therefore, even if one skilled in the art hypothetically combines Simopoulos with Boo, the result is a combination of a water insoluble extract of *Alpinia officinarum* Hance and a water insoluble extract of Purslane. The problem with that combination is that it is not what the Applicant claims in his Claim 1, for example, which specifically recites a water-soluble extract of galangal and a water-soluble extract of Purslane. The combination of Simopoulos with Boo results in water insoluble extracts. Thus, the hypothetical combination fails to teach or suggest the subject matter of Claims 1, 2, 4 and 8-14.

JP '466 discloses a cosmetic material composition on containing at least one plant extract selected from several plants among which *Alpinia officinarum* Hance is one. However, JP '466 does not specifically teach or suggest which plant has which beneficial effect. Consequently, one skilled in the art has no particular reason to select an extract from *Alpinia officinarum* Hance. At best, it would be nothing more than "obvious to try" *Alpinia officinarum* Hance, which was long ago banned by the Federal Circuit.

Furthermore, JP '466 does not teach or suggest which type of extract, *i.e.*, water soluble or insoluble is used. Consequently, one skilled in the art has no reason to select the water soluble extract. On the contrary, as the active molecules are very often soluble in organic solvents as taught by Boo, one skilled in the art would be lead to the water insoluble extract or the organic solvent soluble extract.

The Applicant respectfully submits that a hypothetical combination of JP '466 with Boo would also fail to teach or suggest the subject matter of Claims 1, 2, 4 and 8-14. As noted above, the Applicant has already established that Boo teaches water insoluble extracts of *Alpinia officinarum* Hance. JP '466 has a similar problem inasmuch as JP '466 does not provide any teachings or suggestions as to whether the extract is water soluble or insoluble. In fact, there is no discussion at all with respect to water solubility or the lack thereof. As a consequence, the Applicant respectfully submit that the JP '466 is actually not enabling with respect to a disclosure concerning water soluble extract of *Alpinia officinarum* Hance.

On the other hand, the Applicant has established that the *Alpinia officinarum* Hance of Boo is a water insoluble extract. Thus, if one skilled in the art were to make any selection of *Alpinia officinarum* Hance, that selection would likely be a water insoluble extract in view of the teachings of Boo.

The further problem with the hypothetical combination of Simopoulos with JP '466 is, as noted above, that Simopoulos discloses a water insoluble extract. Thus, one skilled in the art would be combining water insoluble Purslane with *Alpinia officinarum* Hance from JP '466 that is not enabling with respect to its water solubility (but is taught by Boo as being water insoluble). The result is that the hypothetical combination would still fail to teach or suggest the subject matter of Claims 1, 2, 4 and 8-14. In particular, the hypothetical combination would result in water insoluble extracts of Purslane and non-enabled extract of *Alpinia officinarum* Hance since there is no disclosure in JP '466 concerning water solubility.

Underlining this entire series of combinations is essentially the fact that the rejection relies on a random choice of random components from three different references and combines them together without any particular motivation to do so. This is nothing more than the notorious “obvious to try” scenario that is no longer permitted. As a consequence, the Applicant respectfully submit that Claims 1, 2, 4 and 8-14 are patentable over Boo, JP ‘466 and Simopoulos, whether taken individually or collectively. Withdrawal of the rejection is respectfully requested.

The body of the above rejection also refers to Dimentii although the opening portion of the rejection on page 2 does not refer to Dimentii. The Applicant will, nonetheless, briefly address Dimentii as set forth below.

Dimentii relates to the food industry, in particular, margarine, cream butter, various fillings and full fat milk substitutes. Dimentii is in no way related to the cosmetic field. Dimentii teaches that a vegetable extract, such as Hierochloe grass extract at 0.0003% to 0.0005% (per dry weight) may stabilize fat emulsions and, more particularly, with emulsions comprising an emulsifier. The content taught in Dimentii is very far from those of Claim 5, *i.e.*, 0.1 to 10% by weight.

It is not disclosed that the vegetable extract is a water soluble extract. The fact that the extract is added to the water phase does not mean that it is a water soluble extract since a water insoluble extract can as well be added to an aqueous phase.

The advantages to the use of vegetable extract relate to antioxidant and bactericide action, meaning they have a stabilizing effect on aqueous and fat phases relative to food composition.

Since the Applicant provides a cosmetic composition, which may or may not be in the form of an emulsion, which provides freshness and has a draining action so as to attenuate red blotches on the skin and the formation of pouches under the eyes, one skilled in the art is not to be lead to use an extract of Hierochloe grass, and even less a water soluble extract.

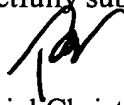
One skilled in the art can readily see that hypothetically combining Dimentii with any of the other three above mentioned references would still fail to provide teachings or suggestions that would cure the deficiencies set forth above. Thus, to the extent that Dimentii is meant to be combined with any or all of the above mentioned Boo, JP’ 466 and Simopoulos references, the Applicant respectfully submits that such a hypothetical combination would still fail to teach or suggest the subject matter of Claims 1, 2, 4 and 8-14.

Claims 3 and 5-7 stand rejected under 35 U.S.C. §103 over the hypothetical combination of Barrett, Plant Guide and Bracco with Boo, JP ‘466, Dimentii and Simopoulos. The Applicant

respectfully submit that all of Barrett, Plant Guide and Bracco fail to provide teachings or suggestions that would cure the deficiencies set forth above with respect to Boo, JP '466, Dimentii and Simopoulos. Withdrawal of the rejection of Claims 3 and 5-7 is accordingly respectfully requested.

In light of the foregoing, the Applicant respectfully submits that the entire Application is now in condition for allowance, which is respectfully requested.

Respectfully submitted,



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